

PTO/SB/30 (10-01)

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REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL Address to: Commissioner for Patents Box RCE Washington, DC 20231	Application Number	09/387,857-Conf. #3099
	Filing Date	September 1, 1999
	First Named Inventor	Fumitaka Sugaya
	Group Art Unit	2822
	Examiner Name	C. Novacek
	Attorney Docket No.	21776-00039-US

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application. Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. **Submission required under 37 CFR 1.114**

- a. ☒ Previously submitted
- i. ☒ Consider the amendment(s)/reply under 37 CFR 1.116 previously filed on November 25, 2002
 (Any unamended amendment(s) referred to above will be entered).
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____
- iii. ☐ Other _____
- b. ☒ Enclosed
- i. ☐ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☒ Other Preliminary Amendment

2. **Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(f) required)
- b. ☐ Other _____

3. **Fees** The RCE fee under 37 CFR 1.17 (e) is required by 37 CFR 1.114 when the RCE is filed.


- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments to Deposit Account No. 22-0185
- i. ☒ RCE fee required under 37 CFR 1.17(e)
- ii. ☒ Extension of time fee (37 CFR 1.138 and 1.17)
- iii. ☐ Other _____
- b. ☐ Check in the amount of \$ _____ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

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DEC 23 2002

TECHNOLOGY CENTER 2800

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

Name (Print/Type)	George R. Pettit	Registration No. (Attorney/Agent)	27,369
Signature		Date	December 23, 2002

RCE
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1/23/03

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Docket No.: 21776-00039-US
(PATENT)

Phil. Response
#715
1/23/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Fumitaka Sugaya

Application No.: 09/387,857 ✓

Group Art Unit: 2822

Filed: September 1, 1999

Examiner: C. Novacek

For: A SEMICONDUCTOR DEVICE AND A
METHOD OF MANUFACTURING THE
SAME

FIRST PRELIMINARY AMENDMENT

Box Non-Fee Amendment
Commissioner for Patents
Washington, DC 20231

Dear Sir:

Prior to examining the above-identified RCE application, entry of the previous Amendment under § 1.116 is requested.

Applicants have submitted the changes to the claims under previous § 1.116 in an effort to avoid the rejection under 35 U.S.C. § 112.

As to the rejection of claim 36 under 35 U.S.C. § 102(e) as being unpatentable over Schoenfeld et al. (U.S. Pat. No. 6,010,932), claim 36 is believed to be distinguished from the reference based on, among other things, the recitation of the third step of etching the first conductive film. The first conductive film is divided to conform to a shape of one of the openings until the insulating film region is reached. The result is a hole in the surface of the conductive film exposing the insulating film region. A recess is formed in the surface of the divided first conductive film which conforms to a shape of the other opening.

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It is submitted that the Schoenfeld et al. reference does not show the foregoing steps which provides for a divided conductive film conforming to the shape of an opening which reaches the insulating film region.

Withdrawal of the rejection of claims 38 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Komori et al. (U.S. Pat. No. 5,300,802) in view of Wolf et al. is requested. The acknowledged deficiency in Komori et al., regarding patterning a first conductive layer, acknowledges the fact that the fourth step of claim 38 of providing a mask pattern having at least first and second openings, is not disclosed. Therefore, the fifth step of etching the first conductive film (after patterning) until the element isolation structure is exposed in first and second openings can not be disclosed as well.

Claim 38 is a method claim, and while similar structures may be formed by other methods, the similar resulting structure does not necessarily anticipate or render obvious the method for creating such structures. Accordingly, it is requested that the claim be examined with respect to its recitation of distinct method steps not shown in the reference.

While Wolf may be cited for the proposition that lithography is a conventional method of patterning semiconductor structures, it is not seen how it discloses the specific method steps 4 and 5 of rejected claim 38 to create the first and second openings in the conductive film and simultaneously form a hole extending through the first conductive film below the second opening.


As the application has been previously indicated to contain allowable subject matter, the Examiner is urged to contact the undersigned at the telephone number below to conduct a personal interview in the event that any further cooperation will result in allowance of the application.

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Dated: December 23, 2002

Respectfully submitted,  TECHNOLOGY CENTER 2800

By 
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